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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,134	03/29/2004	Rebecca Wright	3086.EEM	3212

7590

02/28/2006

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EXAMINER

BERMAN, SUSAN W

ART UNIT

PAPER NUMBER

1711

DATE MAILED: 02/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/812,134

Applicant(s)

WRIGHT ET AL.

Examiner

Susan W. Berman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/04</u> . | 6) <input type="checkbox"/> Other: ____. |

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear whether applicant intends to claim a “coating” which is defined as a cured composition adhered to a substrate or a “coating composition” which is defined as a composition for coating a substrate. With respect to claim 3, it is not clear what is meant by “high” UV stabilizer or “high” UV absorber. What is the meaning of and/or the metes and bounds of “high”? The abbreviation “UV” should be replaced with “ultraviolet”. With respect to claims 4, 11 and 12, the claims do not clearly recite that the wax disclosed is a “reactive wax”. With respect to the claims reciting weight percents, the weight percents are indefinite because it is not clear what total weight the percents are based upon. With respect to claims 19-20, it is not clear how a composition could have the recited properties until UV cured into a coating on a substrate. With respect to claims 21, the claim should clearly recite that the article is obtained by applying a composition according to claim 1 and UV curing the composition to get a coated article. With respect to claim 23, it is not clear what is meant by an “appearance coating” or by an “outer belt”.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 4-9, 15, 16, and 18-23 are rejected under 35 U.S.C. 102(a) as being anticipated by WO 03/053728. WO '728 discloses coating compositions comprising water-borne "PUD" resins, a photoinitiator and wetting agents in the Examples. The wetting agents taught are silicone polymers in emulsion form. See page 2, line 14, to page 3, line 13. With respect to claims 5-9, although WO '728 does not specifically teach the ranges of weight percent set forth, the compositions taught by WO '728 comprise the recited components in weight percents within the instantly claimed ranges. With respect to claims 18-20, the properties set forth in the claims are considered to be inherent properties of the compositions disclosed by WO '728 because the same components as are set forth in the claims are taught.

Claims 1-16, 18-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Van Den Berg et al (6,987,135). Van Den Berg et al disclose photoactivatable water borne coating compositions comprising a polyurethane dispersion and a photoinitiator. Table 8 discloses a compositions comprising KIP 100F as photoinitiator, a BYK defoamer, BYK leveler and a polyamide wax orgasol each in amounts encompassed by the instant claims..

Claims 1-8 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Weikard et al (6,960,639). Weikard et al disclose aqueous coating compositions based on polyurethane dispersions and a photoinitiator. Table 2 discloses compositions comprising a wax and a BYK leveling additive. The disclosed photoinitiators include alpha-hydroxyalkylphenones, such as KIP photoinitiators (column 14,

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lines 37-59). Light stabilizers, UV absorbers, wetting agents and dispersions are taught in column 15, lines 27-40.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 03/053728, as applied to claims 1, 4-9, 15, 16, and 18-23 above, and further in view of Griswold et al (5,525,427). WO '728 teaches silicone wetting agents but does not mention methylmethoxypolysiloxane. Griswold et al teach a water reducible weatherstrip coating compositions comprising a silicone emulsion, a bath life extender, such as a polyurethane dispersion, and a crosslinking composition. See column 5, lines 29-47. Methylmethoxypolysiloxane is taught as a water reducible resin acting as a bath life extender and water repellant. It would have been obvious to one skilled in the art to employ the polysiloxane taught by Griswold et al in the compositions disclosed by WO '728 in order to take advantage of its function as a bath life extender and a water repellant, taught by Griswold et al.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Wefringhaus et al (6,682,779) disclose aqueous compositions for coating elastomers in automobile manufacturing comprising an aqueous polyurethane dispersion, a means for improving sliding behavior, a surface active and flow control agents.

Tarvin et al (US 2002/0164434) disclose compositions comprising urethane oligomers, surfactants and KIP100F as photoinitiator.

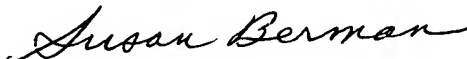
Fang [US 2004/0131787] discloses aqueous tire dressing compositions comprising polyurethane, silicone and polyamide leveling agent.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan W Berman whose telephone number is 571 272 1067. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571 272 1078. The fax phone number for the organization where this application or proceeding is assigned is 571 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SB
2/20/2006


Susan W Berman
Primary Examiner
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